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09/653,360	08/31/2000	Ichiro Nakano	1046.1221/JDH	4207

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EXAMINER
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NGUYEN, KEVIN M

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/653,360	NAKANO ET AL.	
	<b>Examiner</b> Kevin M. Nguyen	<b>Art Unit</b> 2674	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 26 June 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-9,11-20 and 22-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9,11-20 and 22-25 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

1. The amendment filed on 6/26/2003 is entered. The rejections of claims 1-9, 11-20 and 22-25 are maintained.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9, 11-13 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Yano et al (US 5,539,429).

As to claims 1, Yano et al teach an information processing system which includes an operation screen unit 31, a first control circuit 7, an operation mode selecting unit "SW1-SW8" selecting any one of two or more operation modes with respect to the touch operation 26, a first mode is settable to provide a first function "NAVIGATION" corresponding to the touch operation if the touch operation is detected on the touch display screen 26 (see figures 1 and 4, column 3, lines 1-10),

a second mode is settable to provide a second function of displaying a marker "M" for indicating a detection of the touch in a touch position if the touch operation is detected on the display screen 26a, the second function is provided instead of the first function or together with the first function (see figures 10 and 11, column 6, lines 5-14).

As to claim 2, Yano et al teach a connecting module (5, 6), a display device 26, an operation screen unit 31, a first control circuit 7 (see figure 1, column 3, lines 1-10), a

second mode is settable to provide a second function of displaying a marker "M" for indicating a detection of the touch in at least one of a touch position and a display position on the display screen 26 which is determined based on the touch operation if the touch operation is detected on the pointing device 31, the second function "M" is provided instead of the first function "NAVIGATION" or together with the first function (see figures 10 and 11, column 6, lines 5-14).

As to claim 3, Yano et al teach a first control unit 7 executes any one of the display device 26 and the operation screen unit 31 (see figure 1).

As to claim 4, Yano et al teach the connecting module (5, 6), the display device 26, a first display control unit 9 controls a first item of information on the operation screen unit 31, a second display control unit 7 controls a second item of information on the display device 26,

and a second mode is settable to provide a second function of displaying a marker "M" for indicating a detection of the touch in at least one of a touch position and a display position marker "M" on the display screen 26 which is determined based on the touch operation if the touch operation is detected on the pointing device 31, the second function "marker" is provided instead of the first function "NAV" or together with the first function (see figures 10 and 11, column 6, lines 5-14).

4. As to claim 5, Yano et al teach an information processing system associating a method which includes an operation screen unit 31, a first control circuit 7, a control unit 7 distinguishes between operation modes on the operation screen unit 31

a first mode is settable to provide a first function “NAV” corresponding to the touch operation if the touch operation is detected on the touch display screen 31;

a second mode is settable to provide a second function of displaying a marker “M” for indicating a detection of the touch in a touch position if the touch operation is detected on the display screen 26, the second function “marker” is provided instead of the first function “NAV” or together with the first function (see figures 10 and 11, column 6, lines 5-14).

As to claim 6, Yano et al teach an information processing system which includes a connecting module (5, 6), a display device 26, a first control circuit 7, a second mode is settable to provide a second function of displaying a marker “M” for indicating a detection of the touch in a touch position if the touch operation is detected on the display screen 26, the second function “marker” is provided instead of the first function “NAV” or together with the first function (see figures 10 and 11, column 6, lines 5-14).

As to claim 7, Yano et al teach a first control unit 7 executes any one of the display device 26 and the operation screen unit 31 (see figure 1).

As to claim 8, Yano et al teach the connecting module (5, 6), the display device 26, the first display control unit 7 controls a first item of information in addition to the operation screen unit 31, a second display control unit 9 controls a second item of information on the display device 26, and a second mode is settable to provide a second function of displaying a marker “M” for indicating a detection of the touch in at least one of a touch position and a display position on the display screen 26 which is determined based on the touch operation if the touch operation is detected on the

pointing device 31, the second function “marker” is provided instead of the first function “NAV” or together with the first function (see figures 10 and 11, column 6, lines 5-14).

5. As to claim 9, Yano et al teach an information processing system which includes a pointing device 31, a detection unit 9, a display control unit 7 for displaying a marker “M”,

an operation mode selecting unit “SW1-SW8” selecting any one of a first operation mode for providing a first function “NAV” of executing a normal process corresponding to the operator’s input operation using the pointing device 31, a second operation mode for providing a second function “marker” of executing a process different from the first operation mode;

the display control unit 7 executes a process of displaying the marker “M” (see figures 10 and 11, column 6, lines 5-14).

As to claim 11 and 12, Yano et al teach erasing and calculating an elapse time of the marker “key pattern” after the marker has been displayed for a predetermined time (see figure 9, column 6, lines 36-58).

As to claim 13, Yano et al teach a pointing device 12 being a touch panel provided on the display unit 18 (see figure 2).

6. As to claim 15, Yano et al teach a method of controlling and information processing system, to which a display device 26 is connected, having an operation screen unit 31 used for displaying information and for providing a first function “NAV” based on touch operation on its surface, said method comprising, when the information

having the same content (figure 7) is displayed on the display device 26 and on the operation screen unit 31, function of :

detecting a touch operation on said operation screen unit 31; and  
providing, instead of providing a first function "NAV" based on the touch operation, or together with providing the first function "NAV", a second function of displaying a marker in a display position, corresponding to the detected touch position, on said display device 26 (see figures 10 and 11, column 6, lines 5-14).

7. As to claim 16, Yano et al teach of controlling an information processing system, to which a display device 26 is connected, having an operation screen unit 31 capable of displaying information and detecting a touch operation on its surface, said method comprising, when no information (see figure 11) is displayed on said operation screen unit 31, functions of:

detecting the touch operation on said operation screen unit 31;  
displaying a marker "M" in a coordinate position on said display device 26, which corresponds to a position of the detected touch on said operation screen unit 31; and  
providing a function indicated by the marker "M" on said display device 26 (see figures 10 and 11, column 6, lines 5-14).

8. As to claim 17, Yano et al teach a method of controlling an information processing system, to which a display device 26 is connected, having an operation screen unit 31 capable of displaying information and detecting a touch operation on its surface, said method comprising, when different items (see figure 7) of information are displayed on said display device 26 and said operation screen unit 31, function of:

detecting the touch operation on said operation screen unit 31;  
displaying a marker "M" in a coordinate position on said display device 26, which corresponds to a position of the detected touch on said operation screen unit 31; and providing a function indicated by the marker "M" on said display device 26 (see figures 10 and 11, column 6, lines 5-14).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 14, 18-20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yano et al in view of Matsui (US 6,215,479).

As to claim 14, Yano et al teach all of the claimed limitation of claim 9, except for "other display device." However, Matsui teaches a related information processing system 11 which includes other display device 20 (see figure 1, column 9, lines 37-41). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize other display device 20 taught by Matsui for Yano et al's information processing system because this would improve the image being displayed while providing an apparatus at low cost (see column 3, lines 1-5 of Matsui).

As to claim 18, Yano et al teach a storing unit 8 readable by a microprocessor 7 to perform a method of

selecting an information processing system including an operation screen unit 31 capable of displaying information and detecting a touch operation on its surface to any one of two or more operation modes "SW1-SW8" with respect to the touch operation 31; displaying the information on at least one of coordinate input unit 31; a first mode is settable to provide a first function "NAV" corresponding to the touch operation if the touch operation is detected on the touch display screen 26; a second mode is settable to provide a second function of displaying a marker "M" for indicating a detection of the touch in at least one of a touch position and a display position "marker M" on the display screen 26 which is determined based on the touch operation if the touch operation is detected on the operation screen unit 31, the second function "marker" is provided instead of the first function "NAV" or together with the first function (see figures 10 and 11, column 6, lines 5-14).

Yano et al fail to teach other display device connected to the information processing system. However, Matsui teaches a related information processing system 11 which includes other display device 20 (see figure 1, column 9, lines 37-41). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize other display device 20 taught by Matsui for Yano et al's information processing system because this would improve the image being displayed while providing an apparatus at low cost (see column 3, lines 1-5 of Matsui).

11. As to claim 19, Yano et al teach a storing unit 8 readable by a microprocessor 7 to perform a method of displaying the information on at least one of operation screen

unit 31; detecting the touch operation on the operation screen unit 31; distinguishing between operation modes “SW1-SW8” on the operation screen unit 31;

The operation modes “SW1-SW8” include:

a first mode is settable to provide a first function “NAV” corresponding to the touch operation if the touch operation is detected on the operation screen unit 31;

a second mode is settable to provide a second function of displaying a marker “M” for indicating a detection of the touch in at least one of a touch position and a display position “marker M” on the display screen 26 which is determined based on the touch operation if the touch operation is detected on the pointing device 31, the second function “marker” is provided instead of the first function “NAV” or together with the first function (see figures 10 and 11, column 6, lines 5-14).

12. As to claims 20 and 25, Yano et al teach a storing unit 8 readable by a microprocessor 7 to perform a method of

detecting an operator's input operation of indicating the coordinates  $X_o$ ,  $Y_o$  on a display unit 26 by use of a pointing device 31 being connected to the computer 7 (column 4, lines 28-39);

displaying the marker “M” for showing the respective coordinates ( $X_o$ ,  $Y_o$ ) on the display unit 26 indicated by the input operation;

selecting any one of a first operation modes for providing a first function “NAV” of executing a normal process corresponding to the operator's input operation using the pointing device 31, and a second operation mode for providing a second function “marker” of executing a process different from the first operation mode.

Yano et al fail to teach other display device connected to the information processing system. However, Matsui teaches a related information processing system 11 which includes other display device 20 (see figure 1, column 9, lines 37-41). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize other display device 20 taught by Matsui for Yano et al's information processing system because this would improve the image being displayed while providing an apparatus at low cost (see column 3, lines 1-5 of Matsui).

As to claims 22-24, Yano et al teach erasing and calculating an elapse time of the marker "key pattern" after the marker has been displayed for a predetermined time (see figure 9, column 6, lines 36-58).

***Response to Arguments***

13. Applicant's arguments filed 6/26/2003 have been fully considered but they are not persuasive.

In response to applicant's argument that claims 1, 5, and 15 recites "a first mode is settable to provide a first function corresponding to the touch operation if the touch operation is detected on the touch display screen; a second mode is settable to provide a second function of displaying a marker "M" for indicating a detection of the touch in a touch position if the touch operation is detected on the display screen, the second function is provided instead of the first function or together with the first function," at page 9, lines 19-25. This argument is not persuasive because Yano et al's invention teaches a first mode is settable to provide a first function "NAVIGAION" corresponding to the touch operation if the touch operation is detected on the touch display screen 26

(see figures 1 and 4, column 3, lines 1-10); a second mode is settable to provide a second function of displaying a marker "M" for indicating a detection of the touch in a touch position if the touch operation is detected on the display screen 26a, the second function is provided instead of the first function or together with the first function (see figures 10 and 11, column 6, lines 5-14).

In response to applicant's argument that claims 9 and 20 recite "an operation mode selecting unit selecting any one of a first operation mode for providing a first function of executing a normal process corresponding to the operator's unit operation using said pointing device, and a second operation mode for providing a second function of executing a process different from the first operation mode, wherein said display control unit executes a process of displaying the marker on the basis of the selection of the second operation modes," at page 9, lines 26-31. This argument is not persuasive because Yano et al's invention teaches an operation mode selecting unit "SW1-SW8" selecting any one of a first operation mode for providing a first function "NAV" of executing a normal process corresponding to the operator's input operation using the pointing device 31, a second operation mode for providing a second function "marker" of executing a process different from the first operation mode; the display control unit 7 executes a process of displaying the marker "M" (see figures 10 and 11, column 6, lines 5-14).

In response to applicant's argument that claims 16 and 17 recite "detecting the touch operation on said operation screen unit; displaying a marker in a coordinate position on said display device, which corresponds to a position of the detected touch

on said operation screen unit; and providing a function indicated by the marker on said display device," at page 10, lines 2-5. This argument is not persuasive because Yano et al's invention teaches detecting a touch operation on its surface, said method comprising, when no information (see figure 11) is displayed on said operation screen unit 31, functions of: detecting the touch operation on said operation screen unit 31; displaying a marker "M" in a coordinate position on said display device 26, which corresponds to a position of the detected touch on said operation screen unit 31; and providing a function indicated by the marker "M" on said display device 26 (see figures 10 and 11, column 6, lines 5-14).

In response to applicant's argument that "Yano et al inherently includes a storage medium readable by a machine, tangible embodying a program of instructions provided by a CPU 7," at page 10, lines 12-15. This argument is not persuasive because Yano et al's invention teaches a storage medium readable "RAM 8, CD-ROM 25a" by a computer 7 (see figure 1, column 4, lines 28-39).

In response to applicant's argument that claims 18 and 19 recite "a storage medium readable by a machine, tangible embodying a program of instruction provided by the machine to perform a method for processing in response to user instruction using an operation screen unit, the method comprising a first mode is settable to provide a first function corresponding to the touch operation if the touch operation is detected on the touch display screen; a second mode is settable to provide a second function of displaying a marker for indicating a detection of the touch in a touch position if the touch operation is detected on the display screen, the second function is provided instead of

the first function or together with the first function," at page 10, lines 23. This argument is not persuasive because Yano et al's invention teaches a first mode is settable to provide a first function "NAV" corresponding to the touch operation if the touch operation is detected on the touch display screen 26; a second mode is settable to provide a second function of displaying a marker "M" for indicating a detection of the touch in at least one of a touch position and a display position "marker M" on the display screen 26 which is determined based on the touch operation if the touch operation is detected on the operation screen unit 31, the second function "marker" is provided instead of the first function "NAV" or together with the first function (see figures 10 and 11, column 6, lines 5-14).

In response to applicant's argument that claim 2 recites "a second mode is settable to provide a second function of displaying a marker for indicating a detection of the touch in at least one of a touch position and a display position on the display screen which is determined based on the touch operation if the touch operation is detected on said operation screen unit, the second function is provided instead of the first function or together with the first function," at page 10, lines 24-29. This argument is not persuasive because Yano et al's invention teaches a second mode is settable to provide a second function of displaying a marker "M" for indicating a detection of the touch in at least one of a touch position and a display position on the display screen 26 which is determined based on the touch operation if the touch operation is detected on the pointing device 31, the second function "M" is provided instead of the first function

"NAVIGATION" or together with the first function (see figures 10 and 11, column 6, lines 5-14).

For these reasons, the rejections based on Yano et al and Matsui have been maintained.

***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kevin M. Nguyen** whose telephone number is **703-305-6209**. The examiner can normally be reached on MON-THU from 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard A Hjerpe** can be reached on **703-305-4709**.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington, VA, Sixth floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the Technology Center 2600 Customer Service Office  
whose telephone number is (703) 306-0377.

Kevin M. Nguyen  
Patent Examiner  
Art Unit 2674

KN  
September 6, 2003



RICHARD HJERPE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600